

RECEIVED
CENTRAL FAX CENTER

JUL 07 2006

REMARKS

The Applicant has read and considered the Office Action dated March 7, 2006 and the references cited therein. The present application includes pending claims 1-7. No amendments to the claims have been made.

On page 2 of the Office Action, claims 1, 3, 4, 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent No. 5,912,512 (hereinafter referred to as Hayashi et al.). The Applicant respectfully traverses this rejection for the following reasons:

To establish a *prima facie* case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations. See MPEP §§ 706.02(j), 2142 (8th ed.).

Hayashi et al. provide an "engine control apparatus in which, while a security against stealing or the like is assured, an engine or the like can be started by a normal vehicle key and from a remote place" (col. 1, lines 47-50). Provided is an immobilizer electronic control unit 12 (immobilizer ECU) which "prohibits the starting of the engine" (col. 3, lines 60-61) and "stores as an inherent code or the like of a vehicle key" (col. 3, line 67 to col. 4, line 1), only allowing the starting of the vehicle upon input of the inherent code.

Hayashi et al. provides two ways of transmitting the inherent code to the immobilizer ECU 12 in order to allow starting of the vehicle. First, an ignition key 32 is provided including transponder 36 that stores the inherent code (see col. 5, line 17). Following the insertion of the key 32 into the ignition, "the inherent code (CODE) recorded onto the ignition key 32 is input to the immobilizer ECU 12" (col. 7, lines 34-36).

Alternatively, a remote engine starting device 54 is provided including a corresponding remote transponder 72 that stores "a key code, which corresponds to the inherent code recorded onto the ignition key 32" (col. 5, line 67 to col. 6, line 2). When the designation switch 52A on remote switch 52 is pressed, an indication signal is sent to remote engine starting device 54, which in turn outputs "a key code (CODE) corresponding to the inherent code recorded onto the ignition key 32 ... to the immobilizer ECU 12" (col. 9, lines 29-30) from transponder 72.

The inherent code "which serves as a master key ... is recorded in advance when the ignition key 32 is manufactured" (col. 6, lines 25-27). As such, each of the immobilizer ECU 12, ignition key 32 and remote engine starting device 54 are Original Equipment Manufacturer (OEM) components since all function in conjunction based on transmission and verification of this OEM inherent code.

The Office Action states "the claimed after-market bypass kit ... is met by the engine start controlling means" taught by Hayashi et al. The Applicant respectfully disagrees and submits that Hayashi et al. fails to disclose, teach or suggest an "after-market by-pass kit for bypassing said OEM security system upon receipt of a data signal and enabling remote car starting of said vehicle without placing said key in said ignition" as recited in claim 1.

As noted in the Office Action, the Hayashi et al. patent teaches an "engine start controlling means [which] determines whether the key code input from the signal input means corresponds to the vehicle and to codes stored in the code storing means and whether the inherent code input from the inherent code input means corresponds to the vehicle and to codes stored in the code storing means [and] starts the engine based on the results of the determination" (col. 1, line 62 to col. 2, line 3). A closer examination of the Description of the Preferred Embodiments reveals that this functionality of the engine start controlling means corresponds precisely to that of immobilizer ECU 12, which receives on signal line 80C either "the inherent code recorded onto the ignition key 32 or the key code corresponding to the inherent code ... from the amplifying circuit 24 or the amplifying circuit 70 of the remote engine starting device 54 [respectively]" (col. 9, line 66 to col. 10, line 3). In other words, the engine start controlling disclosed in the Summary of the Invention corresponds precisely with the immobilizer ECU 12 disclosed in the Description of the Preferred Embodiments.

As discussed above, the immobilizer ECU 12 is an OEM component which the Applicant respectfully submits does not qualify as "after-market".

Moreover, the Office Action further states that "the claimed OEM security system ... is met by the immobilizer ECU". As such, the Applicant respectfully disagrees with this interpretation and submits that the immobilizer ECU 12 cannot teach both an OEM security system and a by-pass kit "for by-passing said OEM security system", as recited in claim 1.

A more accurate interpretation of Hayashi et al., as set forth in the Applicant's response to the Office Action of July 27, 2005, would be to suggest that the remote engine starting device

54 of Hayashi et al. corresponds to the "by-pass kit for by-passing said OEM security system" claimed in claim 1. However, the Hayashi et al. reference fails to disclose, teach or suggest an "after-market by-pass kit", since the remote engine starting device 54 is an OEM component, as discussed above.

The Office Action contends that "the claimed after-market remote car starter device ... is met by the remote switch (52)" taught by Hayashi et al. However, the Office Action also states that "the claimed remote starter transmitter ... is met by remote switch 52". The Applicant respectfully disagrees with this interpretation and submits that the remote switch 52 of Hayashi et al. cannot meet both the claimed after-market remote car starter device and the claimed remote starter transmitter because the remote starter transmitter is "in wireless communication with said remote car starter device" and remote switch 52 is not in wireless communication with itself.

A more accurate interpretation of Hayashi et al., again as set forth in the Applicant's response to the Office Action of July 27, 2005, would be that the remote engine starting device 54 of Hayashi et al., or more precisely the transponder 72 included therein, corresponds to the "remote car starter device ... in communication with said by-pass kit for sending data signals to said by-pass kit to start said engine" claimed in claim 1. However, here again Hayashi et al. fail to disclose, teach or suggest an "after-market remote car starter device", since remote engine starting device 54 and transponder 72 are OEM components, as discussed above. Moreover, starting device 54 and transponder 72 are not "distinct and separate" as recited in claim 1.

Lastly, the Office Action states that "it would have been obvious to one of ordinary skill in the art that the invention of Hayashi et al. would be able to be installed either at manufacture or at a later date in order to use the device in more vehicles by more users". The Applicant respectfully disagrees and submits that the Hayashi et al. patent provides no motivation to modify any portion of the stealing preventing apparatus 10 disclosed therein to comprise an after-market by-pass kit for by-passing an OEM security system and an after-market remote car starter device distinct and separate from said by-pass kit for sending a data signal to said bypass kit to start said engine.

Pursuant to MPEP § 2143.01, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Hayashi et al. provides a fully functioning OEM security system (immobilizer ECU 12)

and an OEM remote starter device (remote engine starting device 54) that bypasses the OEM security system. The disarming of the immobilizer ECU 12 is accomplished in both cases by inputting of the OEM inherent code (or a corresponding key code) that, as noted above, "serves as a master key and is recorded in advance when the ignition key 32 is manufactured" (col. 6, lines 25-27).

Therefore, the Applicant respectfully submits that no suggestion or motivation has been established, either in Hayashi et al. itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so that it discloses the subject matter of claim 1, pursuant to MPEP §§ 706.02(j), 2142 (8th ed.). The Applicant further submits that the Office Action has failed to show that the prior art teaches or suggests all of the claim limitations, pursuant to MPEP §§ 706.02(j), 2142 (8th ed.). Accordingly, in view of the foregoing, the Applicant respectfully submits that a *prima facie* case of obviousness has not been established and requests that the rejection under 35 U.S.C. § 103(a) be withdrawn. As such, claim 1 is believed to be in condition for allowance.

Claims 3, 4, 6 and 7 depend from claim 1 and therefore include all the limitations of claim 1. As such, claims 3, 4, 6 and 7 are also believed to be in condition for allowance.

On page 4 of the Office Action, claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al. in view of U.S. patent No. 6,265,788 (hereinafter referred to as Davidson et al.). Claim 2 depends from claim 1 and therefore includes all the limitations of claim 1. In addition, the Applicant respectfully submits that the limitations found lacking in Hayashi et al. are not taught, disclosed, nor suggested in Davidson et al. Accordingly, claim 2 is believed to be in condition for allowance.

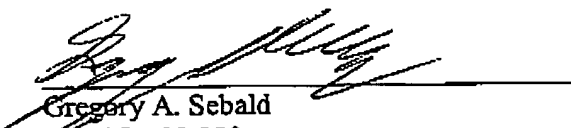
CONCLUSION

In view of the foregoing, the Applicant asserts that claims 1-7 are in allowable form. Favorable reconsideration is requested. The allowance of this application is earnestly solicited. If a telephone interview would be helpful in this matter, please contact Applicant's Representative at the telephone number listed below.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: 7/7/06


Gregory A. Sebald
Reg. No. 33,280
GAS:PLSkaw